

REMARKS

Claims 1, 2, 4-18, and 21-27 were pending at the time of examination. Claims 1, 2, 4-18, and 21-27 stand rejected under 35 USC 103(a) as being unpatentable over Berry et al in view of Simmons et al. Applicant has amended claims 11-15 and 21-27, and has canceled claims 1, 2, 4-7, 8-10, and 16-18. In view of the amendments and arguments set forth below, Applicant respectfully submits that all remaining claims are in condition for allowance.

I. Note regarding the claim amendments.

Independent claims 11, 23, and 24 have been amended to limit their scope to audio data files and audio player units. The corresponding dependent claims have thus been amended to conform to the changes in the independent claims. The Applicant believes that the Examiner may not fully understand what the invention is; therefore, the claims have also been amended in an attempt to clarify the invention for the benefit of the Examiner.

Applicant believes the subject matter of claims 11, 23, and 24 do not constitute a new invention and therefore do not require a new search. The actual subject matter recited in these claims remains substantially the same.

II. Rejection of claims 11-15 and 21-27 under 35 USC 103(a).

Starting at page 2 of the office action, the Examiner rejected claims 11-15 and 21-27 under 35 USC 103(a) as being unpatentable over Berry et al in view of Simmons et al. Applicant respectfully traverses this rejection.

According to MPEP §706.02(j), “[t]o establish a prima facie case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on Applicants' disclosure.” Applicants respectfully note that in the present case, one

or more of these factors are not present and therefore claims 11-15 and 21-27 cannot be found obvious over Berry in view of Simmons.

IIa. Simmons is not available as prior art.

At pages 2 and 3 of the office action, the Examiner states “Berry does not explicitly teach appending an identifier onto the media file, wherein the identifier uniquely identifies a player unit. However, Simmons teach [sic] appending an identifier onto the media file the identifier uniquely identifies a player unit (see section 0022, 0040).” Contrary to the Examiner’s statement, the Applicant respectfully notes that Simmons is **not available** as prior art.

Simmons has a filing date of February 20, 2001. The Applicant filed his application on August 31, 2000. The Applicant’s filing date therefore precedes the filing date of the Simmons patent application, thereby making Simmons unavailable as prior art.

The Examiner stated by phone that she believes Simmons to have a priority date that precedes the filing date of the Applicant’s application. However, the published version of Simmons patent application, available on the USPTO website, does not contain any priority information. The published version of the Simmons patent application only gives the filing date of February 20, 2001. As such, the Applicant cannot be sure that Simmons truly has a priority date that precedes the Applicant’s filing date. Until the true priority information is shown to the Applicant, the Applicant maintains that Simmons is unavailable as prior art.

IIb. Berry does not disclose certain limitations of claim 11 argued by the Examiner.

At pages 3 and 4 of the office action, the Examiner states “As per claim 11, Berry teaches...Retrieving a message file and producing a message output from the message file if the first identifier does not correspond to the second identifier (col. 10, lines 32-38).”¹ Contrary to what the Examiner states, the Applicant respectfully notes that this statement is incorrect because Berry **does not** teach producing a message output if the first identifier does not correspond to the second identifier.

¹ Claim 11 has been amended to replace “if the first identifier does not correspond to the second identifier” with “if the first alphanumeric identifier does match the second alphanumeric identifier.” The Examiner’s arguments, however, are still applicable.

Berry at col. 10, lines 31-33 clearly states that “If no codes are found to match, as indicated at block 160, then the process **ends**, as illustrated at block 166.” In other words, if the identifiers do not correspond to each other, the process ends. This is the exact **opposite** of what is argued by the Examiner. According to the Examiner, Berry **produces a message output** if the identifiers do not correspond to each other. The Examiner’s argument is therefore erroneous and Berry in fact teaches away from claim 11. For this reason alone, Berry does not support a 103(a) rejection of claim 11.

Furthermore, the “codes” described in Berry are **completely dissimilar** from the “alphanumeric identifiers” recited in the amended claim 11. In Berry, it is very clear that the code is “utilized to identify **unique CD titles** and is based on the Red Book audio CD standard, well known in the art of digitally recorded data” (see, e.g., Berry, col. 10, lines 20-22, and col. 11, lines 34-36). Because the unique identifier of the Berry patent is based on the Red Book standard, a particular CD title will always have the **same** identifier, regardless of which computer system it is played on. For instance, a CD title called “Song 1” will always use the same identifier, regardless of which CD it is stored on, because the identifier comes from the Red Book standard. So if “Song 1” is distributed to 1000 customers, all 1000 copies of “Song 1” will have the exact same identifier.

Unlike Berry, claim 11 uses a completely different type of identifier. The identifier of claim 11 is either “associated with the local audio player unit” or “identifies an audio player unit.” These identifiers are therefore associated with **hardware**, namely audio player units, and are never used to identify CD titles or any other audio files. So in Applicant’s system, if “Song 1” is distributed to 1000 customers, all 1000 copies of “Song 1” will have different alphanumeric identifiers, each identifier being based on the audio player units of the customers.

As such, because MPEP §706.02(j) requires that “the prior art reference (or references when combined) must teach or suggest all the claim limitations,” a 103(a) rejection cannot stand because Berry does not disclose the above limitation “retrieving a message file and producing a message output from the message file if the first identifier does not correspond to the second identifier.” The Applicant respectfully notes that the Examiner’s arguments are incorrect, and the Applicant respectfully requests that claim 11 be allowed.

IIC. Berry and Simmons do not disclose all of the limitations of claim 11.

Claim 11, as amended, recites the following:

“...receiving an audio data file into a local audio player unit, wherein:

a first alphanumeric identifier identifies the local audio player unit, and

a second alphanumeric identifier is appended to the audio data file and identifies an audio player unit;

comparing the first alphanumeric identifier with the second alphanumeric identifier to determine whether they match;

if the first alphanumeric identifier **does match** the second alphanumeric identifier, the method further comprises:

producing an **audio output** from the audio data file; else

if the first alphanumeric identifier **does not match** the second alphanumeric identifier, the method further comprises:

retrieving a commercial message file and producing a **commercial message** output from the commercial message file; **and**

producing an **audio output** from the audio data file.”

In layman's terms, claim 11 states that if the audio file is played in the correct player unit (i.e., the two identifiers **match**), then the audio file is played. If, however, the audio file is played in the wrong player unit (i.e., the two identifiers **do not match**), then the audio file is **still played**, but a commercial is played as well. It is critical to note that in claim 11 **the audio file is played regardless of whether the identifiers match**. This method is **not** disclosed, taught, or suggested by Berry in view of Simmons. In fact, both Berry and Simmons **teach away** from claim 11 because they both teach that the audio file should **not** be played if the identifiers do not match or if the audio file is played on the wrong player unit.

In Berry, if the two identifiers do not match, the process **ends**. This was discussed in section IIb above. In Simmons, if the audio file is played on a player unit other than the designated player unit, the audio file **does not play**. Simmons uses encryption techniques to prevent the audio file from being played outside of one designated player unit, therefore, the encrypted audio file can only be played on the player unit that has the corresponding encryption key. In Simmons, “media files downloaded from the content provider site are dynamically

encrypted before they are transmitted to the player/receiver via the communications network....This insures that the media files can only be decrypted by the same player/receiver which made the request" (section 0045). This teaches away from claim 11 where the audio file is played regardless of which player unit it is in.

Again, because MPEP §706.02(j) requires that "the prior art reference (or references when combined) must teach or suggest *all* the claim limitations," a 103(a) rejection cannot stand because Berry and Simmons do not disclose the claim limitations discussed here. As such, the Applicant respectfully notes that this is another reason claim 11 should be allowed.

IId. Claim 11 is not trying to provide a *secure* system.

The Examiner states at page 4 of the office action that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the teachings of Berry with Simmons to implement the above steps because the system provides a **secure** electronic commerce system that enables media owners to **securely sell or rent** media to users." The Applicant respectfully notes that this statement appears to show that the Examiner may be missing the point of the invention described in claim 11.

In claim 11, the audio data files are **not secure**. This is a *crucial* distinction between the Applicant's invention and the system described in Simmons. Claim 11 is **not** describing a secure system for media owners to securely sell or rent media to users. Instead, claim 11 assumes that users will be illegally sharing the audio data files with other users, and the invention described in claim 11 attempts to partially compensate for the illegal distribution by forcing users to listen to a commercial message when they play an illegal copy. Claim 11 clearly recites that "if the first alphanumeric identifier **does match** the second alphanumeric identifier, the method further comprises **producing an audio output** from the audio data file, else if the first alphanumeric identifier **does not match** the second alphanumeric identifier, the method further comprises retrieving a commercial message file and **producing a commercial message output** from the commercial message file, **and producing an audio output** from the audio data file." In either case the audio file is played. The only difference is that in one case a commercial is played as well. This is why claim 11 is not disclosed or taught by Berry in view of Simmons.

III. There is no motivation to combine Berry and Simmons.

As recited above, MPEP §706.02(j) states that “there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine the reference teachings.” Here, there is no suggestion or motivation to combine the teachings of Berry and Simmons.

One of ordinary skill in the art would logically look to Simmons when looking for methods to securely deliver audio files to a consumer. However, Berry describes a system that has little relevance to the secure delivery of media files. The Berry invention addresses retrieving multimedia content **to enhance or enrich a CD listening experience**. For example, if a person is listening to a song by the Beatles, the system will identify the song by its identifier, and then use that identifier to locate multimedia content relevant to the particular Beatles song that is being played. The system can retrieve and then display images and/or video of the Beatles that can enhance the experience for the user.

Because Berry has no relevance to secure delivery of media files, one of ordinary skill in the art would never think to combine Simmons with a reference such as Berry. Berry contains nothing in its specification that suggests or motivates one to combine it with a system such as the one disclosed in Simmons. As such, Berry cannot be used to support a 103(a) rejection, and the Applicant again respectfully requests that claim 11 be allowed.

IV. Claims 23 and 24.

At pages 4 and 6 of the office action, the Examiner rejected claims 23 and 24 using the same arguments set forth in rejecting claim 11. As such, the Applicant’s arguments provided above apply to claims 23 and 24 as well, and the Applicant respectfully requests that claims 23 and 24 be allowed for the same reasons that claim 11 should be allowed.

V. Conclusion.

Applicant asks that all pending claims be allowed. No fee is believed to be due at this time.